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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,581	06/30/2003	Albert C. West	CREATK/101/US	5210

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SUITE 1400
HARTFORD, CT 06103

EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,581

Applicant(s)

WEST, ALBERT C.

Examiner

Vivian Chen

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 and 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Election/Restrictions

1. The restriction requirement mailed 6/30/2005 contained two inadvertent typographical errors:

(a) Group I should be directed to “claims 1-5, 10-12”; and

(b) Line 6 of paragraph 2 of the previous Office Action should read “catalyst after the additives” with regard to “another and materially different process”. As Applicant correctly pointed out, adding the catalyst before the additives is the claimed process. Adding the catalyst after mixing the other additives to the resin constitutes “another and materially different process”.

2. Applicant's election with traverse of Group I (claims 1-5, 10-12) in the reply filed on 7/21/2005 is acknowledged. The traversal is on the ground(s) that the restriction requirement fails to disclose a different process as a basis for the restriction requirement. As indicated above, the restriction requirement of 6/30/2005 contained an inadvertent typographical error in regard to “another and materially different process” in which the term “before” should have correctly been “after”, which represents a process which is patentably distinguishable from the claimed process steps.

The requirement is still deemed proper and is therefore made FINAL.

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3. Claims 6-9, 13-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/21/2005.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over MELBER (US 5,112,657), in view of ALFORD (US 3,230,184).

MELBER discloses simulated marble compositions comprising thermoset resins and microspheres in typical amounts of 30 or more vol% in order to form a lightweight artificial stone article, wherein the article contains conventional additives such as pigments and fillers. (line 40-58, col. 2; line 1-38, col. 3; line 28-40, col. 9; line 33-50, col. 10; line 35-58, col. 15) However the reference fails to explicitly disclose the recited density.

ALFORD discloses that it is well known in the art to obtain thermoset composites having densities of less than 1 g/cc by incorporating microspheres in amounts of greater than 60 vol% (32 wt%) in order to obtain molded articles with desirable strength to weight ratios. (line 74, col. 4 to line 20, col. 5; line 29, col. 7 to line 5, col. 7; Table 1-2)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make incorporate microspheres into thermoset compositions in order to obtain a lightweight artificial stone product. One of ordinary skill in the art would have used effective amounts of known colorants and fillers in order to obtain the appearance of various types and colors of natural stone. Regarding claims 5 and 10, the viscosity of the catalyzed base material is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993).

6. Claims 1-5, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over OKUNO ET AL (US 5,281,633), in view of ALFORD (US 3,230,184).

OKUNO ET AL discloses a molding composition comprising thermoset resins and glass balloons particles in order to form a lightweight artificial stone article, wherein the article contains conventional additives such as pigments and fillers, and wherein the thermoset resins

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have a viscosity of 10^7 or more centipoises. (line 18-20, col. 1; line 5-20, col. 2; line 5-13, col. 3; line 5-7, col. 4) However the reference fails to explicitly disclose the recited density.

ALFORD discloses that it is well known in the art to obtain thermoset composites having densities of less than 1 g/cc by incorporating microspheres in amounts of greater than 60 vol% (32 wt%) in order to obtain molded articles with desirable strength to weight ratios. (line 74, col. 4 to line 20, col. 5; line 29, col. 7 to line 5, col. 7; Table 1-2)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make incorporate microspheres into thermoset compositions in order to obtain a lightweight artificial stone product. One of ordinary skill in the art would have used effective amounts of known colorants and fillers in order to obtain the appearance of various types and colors of natural stone. Regarding claims 5 and 10, the viscosity of the catalyzed base material is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993).

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Conclusions

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 28, 2005



Vivian Chen
Primary Examiner
Art Unit 1773